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10/588,534

10/12/2006

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

12/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/588,534 | Applicant(s) GOUOT ET AL. | |
| | Examiner DANIELLE SULLIVAN | Art Unit 1616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments and arguments filed 05/27/2008 are acknowledged and have been fully considered. Prosecution has been reopened in view of a new rejection. Claims 1-16 remain pending.

Withdrawn rejections

Applicant's amendments and arguments filed 11/24/2008 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below are herein withdrawn.

Response to Arguments

Applicant's arguments, with respect to the rejection(s) of claim(s) 1-16 under USC 103(a) as Mansfield et al. being unavailable as a reference has been fully considered and is persuasive. The Mansfield et al. reference is therefore withdrawn from use.

Applicants additionally argue that individually, the compounds are known in the art, however, they have discovered a combination that clearly exhibits synergism. The Examiner disagrees with this argument. Example 1 shows synergy for compound 1 and carbendazim at a ratio of 1:1, however, synergy has not been demonstrated for all combinations of the structures of formula (I) and compound b). Therefore, the claims are not commensurate in scope with the showing. Applicant has only demonstrated that the combination of N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide (compound 1) and carbendazim at a ratio of 1:1 is synergistic.

New Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moloney et al. WO 99/42447) in view of Brandes et al. (5,532,262).

Applicant's Invention

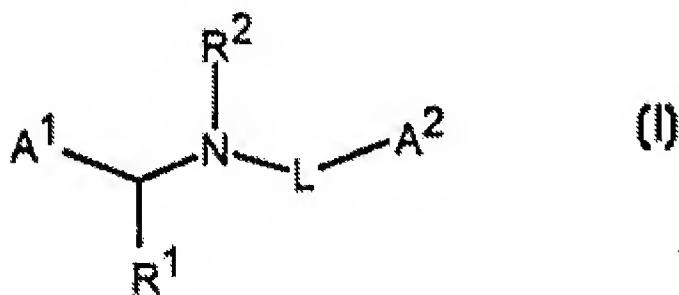
Applicant claims a fungicidal composition comprising a) a pyridylethylbenzamide derivative of formula (I) and b) a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivatives thiopantate, thiopantate-methyl and diethofencarb. Claim 2 and 3 specify the p and q in formula I), respectively, is 2. Claim 4-7 specify X and Y in formula I), respectively are selected from halogen and haloalkyl, preferably, chlorine or trifluoromethyl. Claim 8 and 9 specify formula I) is N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. Claim 10 and 11 specify b) is a benzimidazole derivative, preferably selected from benomyl, carbendazim and thiabendazole. Claim 12 specify b) is selected from diethofencarb. Claim 13 and 14 specify and addition fungicide, preferably selected from iprodione and chlorotalonil. Claim 15 specify the composition comprises a support, carrier, filler and/or surfactant.

Applicants also claim a method of controlling phytopathogenic fungi in crops by applying the composition to the seed, plant, fruit or soil.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Moloney et al. teach the pyridylethylbenzamide derivative of formula (I) wherein A1 is a substituted 2-pyridyl, A2 is optionally substituted phenyl, L is $-(C=O)-$, R1 is hydrogen, and A2 is phenyl which can have up to five substituents (page 1, lines 1-20). Species of compounds 1, 3, 12 and 17 are obvious over the pyridylethylbenzamide derivative of formula (I). (See page 15).



The compound is used as a fungicide against mildews, rusts and other fungi (page 4, lines 20-30). The compound may be mixed with one or more insecticides, fungicides, plant growth regulator, etc. (column 5, lines 6-10). The composition is applied in the range of 0.0001 to 1 percent by weight (page 6, lines 34 and 35).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Moloney et al. teach formula (I) as differing in structure. The alkylene group between the pyridyl group and the benzamide moiety taught by Moloney et al. is different from the methylene group disclosed in the present invention. However, the compounds are homologues that differ by a methylene linkage and it would have been

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obvious to one of ordinary skill in the art to synthesis homologues of this class of compounds and compositions.

Also, Moloney et al. do not teach the additional fungicides include a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivative thiopanate, thiopanate-methyl and diethofencarb and the addition fungicide selected from iprodione and chlorotalonil. It is for this reason that Brandes et al. is joined.

Brandes et al. teach fungicidal compositions useful for the control of phytopathogenic fungi (column 1, lines 1-17). The compounds carbendazim (0.25 to 5 parts by weight), diethofencarb (0.5 to 5 parts by weight), iprodione (0.5 to 10 parts by weight), thiopanate, thiopanate-methyl (0.25 to 5 parts by weight) and benomyl are taught display very good fungicidal properties (column 3, line 20-25; column 4, lines 50-65; column 6, lines 19-35).

It would be prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose, "the idea of combining them flows logically from their having been individually taught in prior art." In re Kerkhoven 205 USPQ 1069, (C.C.P.A. 1980). Thus, combining carbendazim, diethofencarb, iprodione, thiopanate, thiopanate-methyl and benomyl with formula (I) is obvious.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Moloney et al. and Brandes et al. to utilize a

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compound selected from a benzimidazole derivatives thiopante, thiopante-methyl and diethofencarb and the addition fungicide iprodione with formula (I). One would have been motivated to utilize these compounds because Brandes et al. teaches that they are known to display fungicidal properties and combining one fungicide with another is *prima facie*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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